

REMARKS/ARGUMENTS

Claims 1-24 remain in this application.

Rejection Under 35 USC 103

I

Claims 1-24 were rejected under 35 USC 103 as being unpatentable over Sunkel et al. (U.S. Patent No. 6,542,598). See Pages 3-4 of the Office Action. Applicants respectfully disagree.

According to the Office Action, "Sunkel et al. teach cosmetic compositions comprising organopolysiloxane elastomers and silicone oils wherein the composition may be in the form of a foundation, mascara, eye shadows, powders, blushes, lip color, and the like. . . . Example II at column 23 demonstrates a mascara composition comprising elastomer gels, silicone oils, pigments, and the like. . . . Applicant's have not demonstrated any criticality based on the claimed invention of less than about 1%, by weight, or wax." See Page 3 of the Office Action.

The invention of claim 1 relates to a "mascara comprising a silicone gel that comprises an organopolysiloxane elastomer and a silicone oil, wherein said mascara comprises less than about 1%, by weight, of wax." Applicants have discovered that the organosiloxane elastomer and silicone oil can be used in place of waxes in mascaras. As previously discussed in prior responses, waxes are not desirable in mascaras. See, e.g., PCT Patent Application No. WO00/74519. Thus, there is criticality to having little to no wax, as recited in claim 1.

The Office Action further states that "Sunkel et al. . . . teach that solidifying agents (i.e., waxes) are present at a concentration of from about 0 to about 90%." See Page 3 of the Office Action. However, as stated above, Sunkel et al. relates to various types of cosmetic compositions. Sunkel et al. does not disclose, nor suggest, how one would make a mascara with 0% wax. In fact, as stated in previous Responses, Sunkel et al actually teaches away from such as the mascara set forth in Example II of Sunkel et al. comprises 11.25% of wax. Thus, Sunkel et al. does not teach, nor suggest, the mascara recited in independent claim 1 of the present application, which "comprises less than about 1%, by weight, of wax."

Accordingly, Applicants respectfully request that the above rejection under 35 USC 103(a) be withdrawn.

II

Claims 1-24 remained rejected under 35 USC 103 as being unpatentable over Shukuzaki et al. (U.S. Patent No. 5,266,321) in view of Sunkel et al. (U.S. Patent No. 6,542,598). See Pages 4-5 of the Office Action. Applicants respectfully disagree.

According to the Office Action, Shukuzaki et al. teach an oily make-up cosmetic comprising a silicone gel composition . . . Shukuzaki is deficient only in the sense that he does not explicitly teach the make-up cosmetic in the form of mascara. . . . It would have been obvious to one of ordinary skill in the pharmaceutical art at the time the invention was made to use the teachings of Sunkel et al. within the teachings of Shukuzaki et al. because Sunkel et al. explicitly teach cosmetic compositions comprising organosiloxane elastomers and silicone oils wherein the cosmetic composition may be in the various form, such as . . . mascara.” See Pages 4-5 of the Office Action. Applicants respectfully disagree.

Applicants invention relates to a mascara that “comprises less than about 1%, by weight, of wax.” As acknowledged in the Office Action, Shukuzaki is silent with respect to mascaras. As discussed above, Sunkel et al. fails to disclose, or suggest, such as mascara of claim 1, and in fact teaches away from such a mascara.

The Office Action states on the bottom of page 7 that the “prior art teaches the use of ‘low viscosity’ silicone oils to provide for ‘better make-up effects and superior stability.’” No reference for such statement, however, is provided in the Office Action. In any event, the Applicants are not claiming in claim 1 any mascara that contains a ‘low-viscosity silicone oil,” but rather are claiming a mascara that (i) comprises a silicone gel that comprises an organopolysiloxane elastomer and a silicone oil and (ii) comprises less than about 1%, by weight, of wax.” As discussed above, neither Sunkel et al. nor Shukuzaki et al. disclose, or suggest such a mascara. Shukuzaki et al. is silent to mascaras, and Sunkel et al. actually teaches away from mascaras comprising less than about 1%, by weight, of wax.

Accordingly, Applicants respectfully request that the above rejection under 35 USC 103(a) be withdrawn.

Serial No. 09/938,454

Please note, Applicants also still respectfully request acknowledgement of receipt of the Second Supplemental Information Disclosure Statement filed August 30, 2003.

Applicants also respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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